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09/898,707	07/03/2001	Thomas Zickell	NEI-010XX	2439

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EXAMINER

AUGHENBAUGH, WALTER

ART UNIT

PAPER NUMBER

1772

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/898,707	ZICKELL, THOMAS
	Examiner Walter B Aughenbaugh	Art Unit 1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 27 February 2003.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-20 is/are pending in the application.

4a) Of the above claim(s) 16-20 is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1 and 3-15 is/are rejected.

7) Claim(s) 2 is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. _____.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____

4) Interview Summary (PTO-413) Paper No(s) _____

5) Notice of Informal Patent Application (PTO-152)

6) Other: _____

DETAILED ACTION

Claim Objections

1. Claim 2 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 1 does not require “another portion of said bottom surface of said substrate” since claim 1 reads in part “an adhesive composition disposed on at least a portion of said bottom surface of said substrate”. In the case where the adhesive composition is disposed on the entire bottom surface of the substrate, there cannot be “another portion of said bottom surface of said substrate”.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 2, 3, 8 and 12-15 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In regard to claim 2, the phrase “another portion of said bottom surface of said substrate” is indefinite when considered with claim 1. What is “another portion” referring to?

In regard to claim 3, the term “wider” and the phrase “a region of greater than double coverage” renders the claim indefinite. The direction intended to be recited by the term “wider” relative to the covering material (as in length, width, thickness) cannot be ascertained. The structure intended to be recited by the phrase “a region of greater than double coverage” cannot

be ascertained. What does "a region greater than double coverage" mean? What does "double coverage" mean, i.e. what components are involved in the "double coverage"? How is "greater than double coverage" distinguished from solely "double coverage"; what does "greater than double coverage" mean?

Claim 3 recites the limitation "said surface" in the fifth line of the claim. There is insufficient antecedent basis for this limitation in the claim. Which surface?

In regard to claims 8 and 12, "SBS" must be written out in full.

Claim 13 and 15 recites the limitation "has a low fuel content compared to said adhesive composition" in the second through third lines of the claim. There is insufficient antecedent basis for this limitation in the claim. Claim 1 [or 14] does not specify that fuel is in either the asphalt or adhesive composition. How could there be a low fuel content in the asphalt composition as compared to the adhesive composition as claim 13 [or 15] specifies, when claim 1 [14], upon which claim 13 [15] depends, does not require that there be fuel in either composition? Furthermore, is the basis for amount intended to be amount (about twice by weight)?

Claim 14 recites the limitation "said bottom surface" in lines 12 and 20 of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim 14 recites the limitation "said covering material" in lines 15, 19 and 23 of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim 14 recites the limitation "said surface" in line 15 of the claim. There is insufficient antecedent basis for this limitation in the claim. Which surface?

Claim 14 recites the limitation "said decorative surface" in line 16 of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim 14, and claim 15 which is dependent upon claim 14, has not been treated on its merits due to the lack of antecedent basis issues.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 1, 3, 4, 9 and 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simpson et al. in view of McGroarty et al.

Simpson et al. teach a rolled covering material (col. 6, lines 19-34 and 56-58), for use in covering a surface by overlapping strips of the covering material (col. 6, lines 35-38), comprising a substrate having upper and lower surfaces (impregnated mat, item 92, col. 5, lines 34-54), an asphalt composition saturating the substrate (col. 5, lines 48-54) and coating the upper surface of the substrate to form a decorative surface area (coating, item 24, col. 3, lines 25-29 and col. 4,

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lines 36-39) on the upper surface of the substrate, a decorative material adhered to the asphalt composition on the decorative surface area (aluminum foil sheet, item 18, col. 3, lines 11-19), an adhesive composition disposed on at least a portion of the bottom surface of the substrate to form an adhesive surface area (adhesive, item 94, col. 5, lines 48-62) and a release backing disposed over the adhesive surface area (release paper, item 96, col. 5, lines 48-62).

The phrase "capable of adhering to said clean surface area when overlapping strips of said covering material are applied to cover said surface such that said decorative surface area is exposed" (lines 13-16) has not been given patentable weight since it has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense.

In re Hutchison, 69 USPQ 138.

The phrases "for use in covering a surface by overlapping strips of the covering material" (lines 1-2) and "for preventing said adhesive surface area from adhering to said decorative surface area when said covering material is rolled" (lines 18-19) are intended use phrases that have not been given patentable weight since it has been held that a recitation with respect to the manner in which a claimed article is intended to be employed does not differentiate the claimed article from a prior art article satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQd 1647 (1987).

Simpson et al. fail to teach that the asphalt composition saturating the substrate coats a portion of the upper surface of the substrate to form a clean surface area on the upper surface of the substrate.

McGroarty et al., however, disclose a waterproofing sheet (item 10) that is especially valuable for use on roofs, having an edge portion (item 13, Fig. 1) that is left without the layers that are coextensive over the remainder of the sheet (excluding edge portion, item 13) so that the sheets can be lapped so that the sheets, when installed, provide a continuous impervious layer (col. 2, line 49-col. 3, line 11 and Fig. 1 and 2). Therefore, one of ordinary skill in the art would have recognized to have coated the asphalt composition on the upper surface of the substrate to the form a clean surface area on the upper surface of the substrate in order to enable strips of the covering material to be lapped together so that the sheets, when lapped together, provide a continuous impervious layer as taught by McGroarty et al.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have coated the asphalt composition on the upper surface of the substrate of Simpson et al. to the form a clean surface area on the upper surface of the substrate in order to enable strips of the covering material to be lapped together so that the sheets, when lapped together, provide a continuous impervious layer as taught by McGroarty et al.

In regard to claim 3, Simpson et al. fail to teach that the decorative surface area is wider than the clean surface area since Simpson et al. does not teach a clean surface area as claimed in claim 1 of the instant application. McGroarty et al., however, disclose a waterproofing sheet (item 10) that is especially valuable for use on roofs, having an edge portion (item 13, Fig. 1) that is left without the layers that are coextensive over the remainder of the sheet (excluding edge portion, item 13) so that the sheets can be lapped so that the sheets, when installed, provide a continuous impervious layer (col. 2, line 49-col. 3, line 11 and Fig. 1 and 2). Furthermore, McGroarty et al. teach that the decorative surface area (waterproofing layer, item 11, col. 4, lines

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49-60) is wider than the clean surface area (edge portion, item 13) (see Fig. 1). Examiner interprets the term "wider" as claimed by Applicants to refer to the length along the direction of the sheet that is perpendicular to the longer edges of the sheet of McGroarty et al. Therefore, one of ordinary skill in the art would have recognized to have coated the asphalt composition on the upper surface of the substrate to form a clean surface area on the upper surface of the substrate where the decorative surface area is wider than the clean surface area as taught by McGroarty et al. in order to enable strips of the covering material to be lapped together so that the sheets, when lapped together, provide a continuous impervious layer as taught by McGroarty et al.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have coated the asphalt composition on the upper surface of the substrate to form a clean surface area on the upper surface of the substrate where the decorative surface area is wider than the clean surface area as taught by McGroarty et al. in order to enable strips of the covering material to be lapped together so that the sheets, when lapped together, provide a continuous impervious layer as taught by McGroarty et al.

In regard to claim 4, Simpson et al. teach that the substrate includes a fibrous material (non-woven polyester fiber mat, item 92, col. 5, lines 45-62). In regard to claim 9, Simpson et al. teach that the surface of the substrate (mat, item 92), and therefore the clean surface area of the substrate taught by Simpson et al. and McGroarty et al., is roughened in texture due to the unwoven polyester fibers (col. 5, lines 55-60), and therefore, that the clean surface area has exposed fibers on the upper surface of the substrate. The phrase "has been scraped" is a process limitation that has not given patentable weight since the method of forming the covering material

is not germane to the issue of patentability of the covering material itself. In regard to claim 11, Simpson et al. teach that the adhesive composition. In regard to claim 11, Simpson et al. teach that the adhesive composition includes a rubberized asphalt material (col. 6, lines 21-34; styrene-butadiene radial block polymer is a rubber).

In regard to claim 12, Simpson et al. teach that the adhesive composition includes by weight 13% styrene-butadiene radial block polymer, 12% sand (filler), 7% oil and 63% bitumen (flux asphalt, col. 4, lines 35-39). Normally, it is to be expected that minor changes in the relative amounts of rubber, filler, oil and asphalt in an asphalt based adhesive would be an unpatentable modification. Under some circumstances, however, changes such as a change to the relative amounts of rubber, filler, oil and asphalt in an asphalt based adhesive may impart patentability to an article if the particular ranges claimed produce a new and unexpected result which is different in kind and not merely in degree from the results of the prior art. *In re Boesch and Slaney*, 205 USPQ 215 (CCPA 1980).

In regard to claim 13, while Simpson et al. or McGroarty et al. do not explicitly teach that an amount of the asphalt composition is about twice an amount of the adhesive composition to improve fire resistance, the substrate (item 92) which comprises the asphalt composition and the coating (item 24) of the asphalt composition of Simpson et al. are depicted as being thicker than the single adhesive layer (item 94) (Fig. 1 and 9). one of ordinary skill in the art would have recognized that the asphalt composition is present in the covering material taught by Simpson et al. or McGroarty et al. in a larger amount than the adhesive composition. Futhermore, It would have been obvious to one of ordinary skill in the art at the time the invention was made to have adjusted the relative amounts of the asphalt and adhesive compositions via routine

experimentation in order to determine the relative amounts of the asphalt and adhesive compositions that yields the optimum fire resistance depending on the desired end user result, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art in the absence of unexpected results. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

6. Claims 5-8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simpson et al. in view of McGroarty et al., and in further view of Kennepohl et al.

In regard to claim 5, Simpson et al. and McGroarty et al. teach the covering material as discussed above. Simpson et al. and McGroarty et al. fail to teach that the substrate is a fiberglass mat. Kennepohl et al., however, disclose that fiberglass webs are a noncombustible substrate for saturation and coating with asphalt compositions for use as building materials such as roofing materials (col. 1, lines 20-53 and col. 9, lines 4-13). Therefore, one of ordinary skill in the art would have recognized to have used a fiberglass mat as the substrate of the covering material of Simpson et al. and McGroarty et al. since it is notoriously well known to those of ordinary skill in the art that fiberglass is a suitable noncombustible material for saturation and coating with asphalt compositions for use as a substrate for building materials such as roofing materials as taught by Kennepohl et al.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a fiberglass mat as the substrate of the covering material of Simpson et al. and McGroarty et al. since it is notoriously well known to those of ordinary skill in the art that fiberglass is a suitable noncombustible material for saturation and coating with asphalt

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compositions for use as a substrate for building materials such as roofing materials as taught by Kennepohl et al.

In regard to claim 6, Simpson et al. and McGroarty et al. teach that the asphalt composition includes a mineral filler (e.g. sand, col. 4, lines 25-46). Simpson et al. and McGroarty et al. fail to teach that the asphalt composition includes an oxidized asphalt to increase fire resistance. Kennepohl et al., however, disclose that oxidized asphalt (col. 7, lines 36-55) with a mineral filler (col. 1, lines 20-48) is a notoriously well known noncombustible material for use as roofing. Therefore, one of ordinary skill in the art would have recognized to have oxidized the asphalt composition of Simpson et al. and McGroarty et al. since oxidized asphalt is a notoriously well known noncombustible material for use as roofing as taught by Kennepohl et al.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have oxidized the asphalt composition of Simpson et al. and McGroarty et al. since oxidized asphalt is a notoriously well known noncombustible material for use as roofing as taught by Kennepohl et al.

In regard to claim 7, Simpson et al., McGroarty et al. and Kennepohl et al. teach the covering material as discussed above. While Simpson et al. and McGroarty et al. fail to teach that the mineral filler is limestone, Kennepohl et al. teach limestone as a conventionally used filler for use in a noncombustible mineral filled asphalt coating for asphalt roofing material (col. 5, lines 62-col. 6, line 3). Therefore, one of ordinary skill in the art would have recognized to have used limestone as the mineral filler of the covering material since limestone is a notoriously

well known filler for use in a noncombustible mineral filled asphalt coating for asphalt roofing material as taught by Kennepohl et al.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used limestone as the mineral filler of the covering material of Simpson et al. and McGroarty et al. since limestone is a notoriously well known filler for use in a noncombustible mineral filled asphalt coating for asphalt roofing material as taught by Kennepohl et al.

In regard to claim 8, Simpson et al. teach styrene-butadiene block copolymer in an amount of 13% by weight (col. 4, lines 22-44). Kennepohl et al. teach that the limestone filler is present in the asphalt composition in an amount of 50% by weight of the asphalt composition (col. 6, lines 35-36) and that the remainder is oxidized asphalt (col. 6, lines 1-61). Normally, it is to be expected that minor changes in the relative amounts of filler, asphalt and rubber in an asphalt composition would be an unpatentable modification. Under some circumstances, however, changes such as a change to the relative amounts of filler, asphalt and rubber in an asphalt composition may impart patentability to an article if the particular ranges claimed produce a new and unexpected result which is different in kind and not merely in degree from the results of the prior art. *In re Boesch and Slaney*, 205 USPQ 215 (CCPA 1980).

In regard to claim 10, Simpson et al. and McGroarty et al. fail to teach that the decorative material includes a granular material deposited on the asphalt composition. Simpson et al. teach that the purpose of the aluminum foil is to reflect infrared and ultraviolet rays impinging on the roof from the sun (col. 1, lines 40-49). Kennepohl et al. teach that a coating of decorative, reflective finely divided stone (i.e. a granular material) on the asphalt composition (col. 1, lines

38-48). Therefore, one of ordinary skill in the art would have recognized to have replaced the aluminum foil taught by Simpson et al. with the granular material taught by Kennepohl et al. since Kennepohl et al. teach the use of the granular material as a reflective material, as the aluminum foil taught by Simpson et al. is used as a reflective material.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have replaced the aluminum foil taught by Simpson et al. with the granular material taught by Kennepohl et al. since Kennepohl et al. teach the use of the granular material as a reflective material, as the aluminum foil taught by Simpson et al. is used as a reflective material.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Walter B Augenbaugh whose telephone number is 703-305-4511. The examiner can normally be reached on Monday-Friday from 9:00am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on 703-308-4251. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

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06/16/03 WBA


HAROLD PYON
SUPERVISORY PATENT EXAMINER
1992

2/16/03